

REMARKS

The Examiner rejected claims 1-6 and 8-40 under 35 U.S.C. §103 (a) as unpatentable over U.S. Patent No. 5,109,413 to Comerford *et al.* (hereinafter "Comerford") in view of U.S. Patent No. 5,629,980 to Stefik *et al.* ("Stefik"). The Examiner rejected Claim 7 as being unpatentable over Comerford in view of Stefik and further in view of U.S. Patent No. 6,230,267 issued to Richards (hereinafter "Richards"). Reconsideration and allowance of the application are requested.

The claim rejections should be withdrawn because (1) the primary Comerford and Stefik references are not properly combinable under § 103, and (2) even if combined, the references do not teach each and every limitation of the claims.

I. The References As Combined Do Not Teach The Claim Limitations

With regard to Claim 1, e.g., contrary to what the Examiner asserts, neither Comerford, nor Stefik teach or suggest allowing access to an encrypted data item having paged subsets that are accessible a paged subset at a time. Specifically, the cited references do not teach or suggest:

...access to an encrypted data item, the encrypted data item having paged subsets that are accessible a paged subset at a time using the same instance of permission for each paged subset...wherein at any one time only one computer retains the instance of permission and is able to use the instance of permission to gain access to a paged subset...;

as recited in claim 1.

Comerford discloses transferring rights to execute software. Comerford does not in any way relate to data items having paged subsets. There is thus no teaching or suggestion whatsoever of any paged subsets, much less of paged subsets that are accessible a paged subset at a time using the same instance of permission.

Stefik also does not teach or suggest allowing access to an encrypted data item having paged subsets that are accessible a paged subset at a time. First, Stefik does not disclose paged subsets. As pointed out by the examiner, Stefik teaches "encrypted digital works" that themselves may be composed of "components" in col. 11, lines 30-67 and col. 12, lines 1-39.

Stefik does not teach that the components can be paged subsets. In fact, the term "paged subsets" is not mentioned anywhere in the reference.

Second, even if Stefik's "components" could somehow be construed to be paged subsets, there is no teaching or suggestion that these components could only be accessed **one at a time**. In discussing the idea of "components" of a digital work, Stefik states that different components can have "different usage rights." More specifically, Stefik writes:

The attachment of usage rights into a digital work may occur in a variety of ways. If the usage rights will be the same for an entire digital work, they could be attached when the digital work is processed for deposit in the digital work server. In the case of a digital work having **different usage rights for the various components**, this can be done as the digital work is being created. An authoring tool or digital work assembling tool could be utilized which provides for an automated process of attaching the usage rights." (col. 11, lines 45-53) (emphasis added)

In other words, Stefik only teaches that different components can have different usage rights. Stefik does not disclose how these components can be accessed, much less whether they can be accessed one at a time.

Stefik also teaches "encrypted information packages (IPs)" which are decoded using keys provided by a "central accounting facility" in col. 3, lines 13-29. But Stefik does not teach or suggest that these IPs are paged subsets of a data item. Furthermore, there is no indication that the IPs are only accessible a paged subset at a time to one computer. In fact, the opposite is implied, for the user can do with the IPs as he likes. According to Stefik:

The IPs of interest are selected by the user and are decrypted and stored locally. The IPs may be printed, displayed or even copied to other storage medias." (col. 3, lines 19-22)

In Sprague's system as described by Stefik, IPs (plural) are selected, decrypted, and stored locally. There is no limitation suggested by Stefik that the IPs be selected and decrypted sequentially and not simultaneously, nor is there a limitation that the IPs, once decrypted and stored locally, are only accessible one at a time and only to the one computer possessing permission. For these reasons, Applicants aver that Sprague's system as described by Stefik does not teach the element of the claim. As one of ordinary skill in the art would assume that once decrypted, stored, and copied to other storage media, any number of computers could access the decrypted file at any time, Sprague's system actually teaches away from the claimed invention.

Third, Stefik only discusses the idea of "components" of a digital work in connection with different usage rights. (see passage cited above from col. 11, lines 45-53). If the Examiner considers Stefik's 'usage rights' to be 'permissions', then the claim limitation of "paged subsets that are accessible a paged subset at a time using the same instance of permission" would not be met because Stefik teaches that different components have different usage rights ('permissions').

The other cited reference, Richards, is directed to transporting data on an IC card (smart card), and adds nothing with respect to any of the above.

Claim 1 and its dependent claims are thus allowable over the cited references. The remaining claims in the application are similarly allowable.

II. Comerford And Stefik Are Not Properly Combinable

In any event, Comerford and Stefik are not properly combinable under §103. The examiner admits "Comerford et al (US 5109413) teaches a software asset protection mechanism that **segregates software from a separate 'right to execute'** the software (see abstract)." (emphasis added) Yet Stefik's system requires that the digital work **not** be segregated from its usage rights. According to Stefik:

It is fundamental to the present invention that the usage rights are treated as part of the digital work. (col. 11, lines 33-34)

Stefik further notes:

A key feature of the present invention is that usage rights are permanently "attached" to the digital work. (col. 6, lines 51-53)

As the modification of the references proposed by the Examiner would require a change in a **fundamental aspect** and principle of operation of the cited references, one skilled in the art would not only have no motivation to, but would be taught away from making the combination. The references are therefore not properly combinable.

For at least the reasons stated above, we submit that claims 1-40 are allowable and therefore request issuance of a Notice of Allowance.

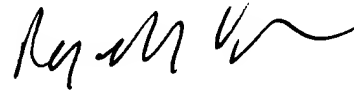
Applicant : Leonard M. Kawell, Jr.
Serial No. : 09/167,888
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Page : 5

Resp. to Office Action mailed: September 29, 2003
Attorney's Docket No.: 107755.117 US1

Applicants hereby request a three-month extension of time to respond to the Office Action mailed September 29, 2003. The commissioner is hereby authorized to charge the required fee of \$950 for filing the request for extension of time to our Deposit Account No. 08-0219.

Please charge any additional fees or credit any overpayments to Deposit Account No. 08-0219.

Respectfully submitted,



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